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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte UWE HANSMANN, LOTHAR MERK, and
THOMAS STOBER

Appeal 2009-014351
Application 10/037,700
Technology Center 2100

Before JAMES D. THOMAS, JOSEPH L. DIXON, and
MAHSHID D. SAADAT, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL ¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

I. STATEMENT OF THE CASE

The Patent Examiner rejected claims 21-29. Claims 1-20 and 30-43 are cancelled. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

A. INVENTION

Appellants state that the invention relates to “the sharing of data between a plurality of databases. More specifically, the invention relates to the synchronization of such data. Still more specifically, the invention pertains to the synchronization of data between a server system and a mobile client.” (Spec. 1).

The present invention discloses a method and system for minimizing code needed in a client to synchronize data records in the client with data records in a server system. The method and system of the present invention includes creating setup information in the client and providing the same to the server, wherein the setup information enables the server system to identify the client and to provide appropriate commands for the client.

(Spec. 6).

B. ILLUSTRATIVE CLAIM

Claim 21, which further illustrates the invention, follows.

21. A client computer system for synchronizing data records stored on the client computer system with data records stored on a server system, the client computer system comprising:

a database for storing the data records; and

a processor coupled to the database for creating setup information to the server system, wherein the setup information enables the server system to identify the client, to identify where to find information the server system needs for synchronization and to provide appropriate commands for the client.

C. REFERENCES

The Examiner relies on the following references as evidence:

Bauer	US 5,870,759	Feb. 9, 1999
Alam	US 6,324,544 B1	Nov. 27, 2001

D. REJECTIONS

Claims 22, 24, and 26 (claims 27-29 due to their dependency on claim 26 as containing all the same “means” limitations), stand rejected under 35 U.S.C. § 112, second paragraph as failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention. (Supp. Ans. 4 ²).

Claims 21-24 and 26-29 stand rejected under 35 U.S.C. § 102 as being anticipated by Bauer. (Supp. Ans. 5-7).

Claim 25 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer in view of Alam. (Supp. Ans. 7).

² We refer to the Examiner’s Answer, mailed May 14, 2009 (“Supplemental Answer.”).

II. ISSUES

Has the Examiner set forth a showing of indefiniteness with respect to the claimed “means plus function” limitations? Specifically, have Appellants responded to the Examiner’s rejection?

Has the Examiner set forth a sufficient showing of anticipation of independent claim 21?

Has the Examiner set forth a reasoned conclusion of obviousness with respect to claim 25?

III. PRINCIPLES OF LAW

35 U.S.C. § 112, SECOND PARAGRAPH

The test for definiteness under 35 U.S.C. § 112, second paragraph, is “whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

With use of the word “means,” a presumption of a means-plus-function clause arises and we “must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.” *In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994).

35 U.S.C. § 102

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628,

631 (Fed. Cir. 1987) (citations omitted). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

Only those arguments actually made by the Appellants have been considered in this decision. Arguments which the Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37 (c)(1)(vii) (2008).

Just as “[i]t is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art,” *In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991), “it is not the function of this Board to examine claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art.” *Ex parte Post*, No. 2005-2042, 2006 WL 1665399 at *4 (BPAI. Jan. 1, 2006).

NEW ARGUMENTS

“[I]t is inappropriate for appellants to discuss in their reply brief matters not raised in . . . the principal brief[]. Reply briefs are to be used to reply to matter[s] raised in the brief of the appellee.” *Kaufman Co. v. Lantech, Inc.*, 807 F.2d 970, 973 n.* (Fed. Cir. 1986). “Considering an argument advanced for the first time in a reply brief . . . is not only unfair to an appellee but also entails the risk of an improvident or ill-advised opinion

on the legal issues tendered.” *McBride v. Merrell Dow and Pharms., Inc.*, 800 F.2d 1208, 1211 (D.C. Cir. 1986) (internal citations omitted). “The failure to raise all issues and arguments diligently, in a timely fashion, has consequences.” *Ex parte Borden*, 93 USPQ2d 1473, 1475 (BPAI 2010) (informative decision).

V. ANALYSIS

NOTICE

In the Order Remanding to the Examiner, mailed November 29, 2006, (Order), the panel was specific in questioning both the rejections under 35 U.S.C. § 112, second paragraph, and under 35 U.S.C. § 103 as to discrepancies therein. (Order 2-3). Therefore, we find that Appellants were on notice to carefully check for changes in the Examiner’s rejections in any subsequent actions. Appellants then had a fair opportunity to carefully check the Supplemental Examiner’s Answer for the noted changes indicated in the Order.

35 U.S.C. § 112, SECOND PARAGRAPH

We pro forma affirm the Examiner’s rejection under 35 U.S.C. § 112, second paragraph, since Appellants have not responded to the modified rejection under 35 U.S.C. § 112, second paragraph. The Examiner’s prior rejection under 35 U.S.C. § 112, second paragraph, which Appellants had addressed in the principal Brief is with respect to different issues. Therefore, Appellants have not responded to this present ground of rejection.

35 U.S.C. § 102

We note that Appellants elected to group claims 21-24 and 26-29 together as a single group in the principal Brief (Reply Br. 6, 13), and

Appellants only provided separate arguments for patentability of dependent claim 25 under 35 U.S.C. § 103 (*id.* at 13).

We find the Examiner has further clarified the statement of the grounds of the rejection in the Supplemental Answer with respect to “creating setup information” with further reliance upon the teachings of Bauer at column 9. (Supp. Ans. 5). Since Appellants have not responded to the Examiner’s Supplemental Answer, Appellants have not shown error in the Examiner’s showing of anticipation, and we will affirm the Examiner’s rejection of independent claim 21.

Since Appellants elected to group independent claim 26 with independent claim 21 in the principal Brief, independent claim 26 and dependent claims 27-29 fall with representative claim 21 (see 37 C.F.R. § 41.37 (c)(1)(vii) (2008)³). We note Appellants’ Reply Brief argues different groupings than initially set forth in the principal Brief, but the Examiner’s rejection and grouping of claims did not change from the final rejection. Therefore, the further modification is inappropriate. We selected

³ “For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.”

independent claim 21 as the representative claim and all claims except claim 25 fall with that claim.

We further requested in the Fifth item of the Order (Order 3) for the Examiner to set forth a claim interpretation as to how the “‘setup information’ limits the client system of independent claim 21,” but we find no response to this item in the Supplemental Answer. We find that the “creating setup information” does positively limit the claimed processor, but the “wherein” is nonfunctional descriptive material which does not positively limit the structure of the processor or client computer system. We find that the information performs no function in the system and is similar to an “intended use” limitation. The “wherein” clause further states that this information can be used to find further information to achieve the feature in the preamble of the claim related to “synchronization.” Yet, the claim never positively states or achieves the preamble’s synchronization or “synchronizing data records.” In response to Appellants’ arguments that the server node in Bauer creates and maintains the table and not the client node (Reply Br. 7), the Examiner at pages 8-9 of the Supplemental Answer discusses the interaction of the client and server with the user to create the table. We find that the Examiner’s discussion shows that the client participates and thereby “creates” the setup information. The claim language does not further limit the “creating”

We sustain the rejection as set forth by the Examiner over the Bauer reference which anticipates the claimed invention.

35 U.S.C. § 103

With respect to dependent claim 25, Appellants rely upon the arguments presented above relating to claim 21. Appellants merely repeat the language of claims 21 and maintain that the Alam reference does not remedy the noted deficiency, but does not address the Examiner's rejection. Therefore, Appellants' argument is essentially the same as that set forth for anticipation. Since we did not find that argument persuasive, we similarly do not find that same argument persuasive with respect to claim 25.

VI. CONCLUSION

For the aforementioned reasons, Appellants have not shown error in the Examiner's showing of indefiniteness of independent claim 26 and dependent claims 22, 24, and 27-29; Appellants have not shown error in the Examiner's showing of anticipation of independent claim 21; and Appellants have not shown error in the Examiner's showing of obviousness of dependent claim 25.

VII. ORDER

We affirm the indefiniteness rejection of claims 22, 24, and 26-29. We affirm the anticipation rejection of claims 21-24 and 26-29 and the obviousness rejections of claim 25.

AFFIRMED

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Application 10/037,700

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